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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/855,905	05/14/1997	MASAAKI YAMANAKA	443-17	2320

7590

01/28/2002

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EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 01/28/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

A-S-927

# Office Action Summary

Application No.

08/855,905

Applicant(s)

YAMANAKA ET AL.

Examiner

Kevin R Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-20 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 claims that the paper has a "gloss of 60% or below." Under the precedence set in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), there is insufficient support for a claim with such an open-ended limitation. Specifically, Applicant has support for one end point of the claimed range (aka 60%) but not for the other (aka 0%).

Claims 1-20 and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 claims that the paper has a opacity of 83% or above. Under the precedence set in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), there is insufficient support for a claim with such an open-ended limitation. Specifically, Applicant has support for one end point of the claimed range (aka 83%) but not for the other (aka 100%).

***Claim Objections***

Claim1 is objected to because of the following informalities: the formatting of the claimed weight percentages is confusing. Specifically, it is confusing to what component each claimed weight percentage refers. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

1. Claims 1-20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashi et al. (Pat. No. 4,318,950) in view of European Patent 0 613 919 A1 (aka Ueda) and Ohba et al. (Pat. No. 5,233,924) for reasons of record.

***Response to Arguments***

I. Applicants' arguments filed December 27, 2001, have been fully considered but they are not persuasive.

Applicants argue that the prior art fails to teach that a sheet's antistatic properties will be enhanced when a composition comprising the claimed antistatic agent is oriented. The examiner believes Applicant is attempting to demonstrate unexpected results with respect to the affect of orientation on surface resistivity. If such is the case, then applicant has failed to make a showing. Specifically, applicant has failed to compare the closest prior art (aka a synthetic paper as taught in Takahashi comprising an anti-static agent other than the claimed polyetheresteramide) to the claimed invention.

Applicants further argue that Ueda fails to show certain features of applicant's invention. It is noted that the features upon which applicant relies (i.e., extrusion) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, a method of making a product does not patentably distinguish a product from the prior art unless it can be shown that the method of making inherently results in a materially different product. No such showing has been made in the present application. It is also noted that Takashi, not Ueda, is the primary reference. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner agrees that Ueda does not teach that the composition may comprise the claimed fillers or that the composition should be opaque. However, the examiner would like to point out that Ueda was never relied upon for such teachings. Rather, Takashi (aka the primary reference) was relied upon to teach the addition of filler to a propylene composition for the purpose of making an opaque synthetic paper. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Takashi teaches neither the claimed antistatic filler nor the amount of antistatic filler that should be added to the propylene composition. The examiner points out that the rejection never relied upon Takashi for such a teaching.

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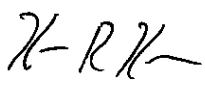
Rather, Ueda teaches the amount of polyetheresteramide containing aromatic rings that need to be added to a composition in order to obtain desirable antistatic effects. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).


Applicant further argues that Ohba is not related art. The examiner respectfully disagrees. The courts have held that that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The examiner maintains the position that Ohba is in the same field of endeavor as the present claims-aka synthetic paper.

Applicant's declarations have been previously considered. A full discussion of each declaration can be found in the previous office actions.

### **Conclusion**

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is (703) 305-0025. The examiner can normally be reached on Monday-Friday from 7:30a.m. to 4:30p.m.

  
Kevin Kruer  
Patent Examiner

  
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